UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto
INVENTION-CON 2017
The Place for Inventors, Makers, & Entrepreneurs
USPTO's Inventors Conference • August 11-12 • Alexandria, VA
Filing for a Patent
Using EFS Web

Presented By:
Zandra Smith
Lisa Tran
Overview

• You will become more familiar with:
  • Methods of filing an application
  • Different types of applications that can be filed
  • Resources available to aid in the filing process
Methods of Filing

- **EFS-Web** - the USPTO’s electronic filing system
  - Filing your nonprovisional utility application via EFS-Web is the only way to avoid paying an additional “non-electronic filing fee”

- **USPS “Priority Mail Express”** to the “Patent Correspondence” address at 37 CFR 1.1.
  - USPS first class mail can be used for correspondence being filed in an existing application

- **Hand delivery to the Customer Service Window** in the Randolph Building of the USPTO Headquarters in Alexandria, Virginia
Online Filing Guides

- Provisional Application for Patent
- Guide to Filing a Design Patent Application
- Plant Patent Application
- Filing a new international application under the Patent Cooperation Treaty (PCT)
  - PCT Legal Administration
  - International Protection
- These guides are available at:
  - https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applicationsproceedings
Different types of applications that can be filed
Provisional Patent Application

- A provisional patent application allows you to file without a formal patent claim, oath or declaration, or any information disclosure (prior art) statement.

- **Items required:**
  - Specification: a written description of the invention, complying with all requirements of 35 USC 112(a)
  - Drawings necessary for the understanding of the invention
  - Filing fee
  - Cover Sheet (PTO/SB/16)
    - [https://www.uspto.gov/web/forms/sb0016_fill.pdf](https://www.uspto.gov/web/forms/sb0016_fill.pdf)
Provisional Patent Application (cont.)

- Use the USPTO cover sheet (PTO/SB/16) to identify:
  - the application as a provisional application for patent;
  - the name(s) of all inventors;
  - inventor residence(s);
  - title of the invention;
  - name and registration number of attorney or agent and docket number (if applicable);
  - correspondence address; and
  - any U.S. Government agency that has a property interest in the application.
Filing Tips – Provisional

• Read the online filing guide before filing: https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/provisional-application-patent

• Claims are not required in a provisional application, but it is recommended that the disclosure of the invention be as complete as possible

• Can be filed up to 12 months following an inventor's public disclosure of the invention (e.g., publication, public use, offer for sale, or any activity that otherwise made the invention available to the public)
  • Such a pre-filing disclosure, although protected in the United States, may preclude patenting in foreign countries

• Provisional applications for patent cannot claim the benefit of a previously-filed application, either foreign or domestic

• May not be filed for design applications
Nonprovisional Patent Application

Filing Requirements for Examination:

- A specification, including a description and a claim or claims
- Drawings, when necessary for an understanding of the invention
- Inventor information including the legal name, residence, and mailing address of each inventor
- Oath or declaration or an application data sheet
- The prescribed filing, search, and examination fees

For more Information:

https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent
Surcharge under 37 CFR 1.16(f)

- A surcharge (in addition to any other fees due) will be assessed for:
  - Late submission of the basic filing, search or examination fee
  - Late submission of inventor’s oath or declaration
  - Filing an application that does not contain at least one claim on filing
  - Submission of an application filed by reference to a previously filed application
Filing Tips – Nonprovisional

- Read the online filing guide before filing: https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent
- Use USPTO forms
  - In general, every applicable section of a form should be completed, but not all sections of a form are applicable to every case
  - If you are unsure which forms to use, ASK!
- Carefully proofread all forms and application papers before submitting
- Register for EFS-Web to file follow-on papers electronically and view your application file wrapper in Private PAIR
  - https://www.uspto.gov/patents-application-process/applying-online/getting-started-new-users
A Design Patent Application should include the following elements (as set forth in 37 CFR 1.154):

- Design application transmittal form
- Fee transmittal form
- Application data sheet (see 37 CFR § 1.76).
- Specification
- Drawings or photographs
- The inventor's oath or declaration (see 37 CFR § 1.153(b))

The filing fee, search fee, and examination fee are also required.
The specification of a Design Patent Application should include the following sections, where applicable, in order:

- Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied
- Cross-reference to related applications (unless included in the application data sheet)
- Statement regarding federally sponsored research or development.
- Description of the figure or figures of the drawing
- Feature description
- A single claim
The drawing disclosure is the most important element of the design application

- It is essential that the applicant present a set of drawings (or photographs) of the highest quality which conform to the rules and policies pertaining to the drawing disclosure of a design patent application

- A design patent application may only include a single claim
  - The claim defines the design the applicant wishes to patent, in terms of the article which embodies the design or to which it is applied
  - The claim must be in formal terms to: “The ornamental design for (the article which embodies the design or to which it is applied) as shown.”

- While no specific format is required for other required information, it is strongly suggested that applicant follow the formats presented in the design filing guide to ensure that the application is complete
Filing Tips – Design

• Read the online filing guide before filing: https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide

• Photographs are permitted if they are the only practicable medium for illustrating the claimed invention

• To meet the requirements of 35 U.S.C. 112, the drawing disclosure must include a sufficient number of views to constitute a complete disclosure of the appearance of the design claimed
  • It is suggested that perspective views be submitted to clearly show the appearance and shape of three-dimensional designs

• Structure that is not part of the claimed design, but is considered necessary to show the environment in which the design is used, may be represented in the drawing by broken lines
EFS-Web Overview

- USPTO’s Web-based electronic filing system (EFS-Web) for patent application submissions

- Available anytime, anywhere with minimal software requirements (e.g., standard Web browser, Internet connection)

- Launched on March 18, 2006

- Immediately routes documents to USPTO internal systems and provides instant electronic Acknowledgement Receipt to user
Electronic Filing Benefits

- Generates Acknowledgement Receipt to show that the USPTO has received the submission
- Reduces manual processing
- Minimizes paper waste
- Automatically feeds information into internal systems
  - Sends notifications to appropriate processing teams (reduce errors in processing, such as lost files)
- Processes faster by avoiding wait times associated with conventional mailing
- Allows for saving submission package to complete, review, or submit at a later time
Security Features and Digital Certificates

- All transactions are secure and encrypted
- Digital Certificate (or PKI, Public Key Infrastructure, Certificate)

  - Provides additional security
  - Enhanced 2-step authentication
  - Grants access to secured features in EFS-Web and Private PAIR
Digital (PKI) Certificate

Patent attorneys/agents and pro se filers may apply by the following process:

1. Applicant completes the Certificate Action Form (CAF)
2. Applicant has the Certificate Action Form notarized by a notary
3. Applicants mails the original form (no faxes or copies)
4. USPTO processes CAF and approves
5. Applicant receives two codes:
   • Authorization Code via e-mail
   • Reference Number via U.S. mail (for U.S. residence only, EBC will attempt one phone call to deliver, or you can contact the EBC to obtain)
6. Applicant uses codes to generate Digital Certificate to access Private PAIR and/or EFS-Web Registered

Digital Certificate Management: site to manage your digital certificate contact information, create a set of recovery codes and to perform self-recovery of damaged or lost digital certificates online
Customer Number

- Allows you to easily correlate all your filings and correspondence with a single mailing address, eliminating typographical errors or variations in addresses that can make it difficult to correspond with the USPTO

- To get your unique Customer Number:
  - PAIR Administration option via Private PAIR
  - OR Complete Customer Number Request form and fax it to the EBC at 571-273-0177
Customer Number

• To associate existing patent applications to a Customer Number:
  • PAIR Administration (Attorneys or Agents with Registration Numbers only)
  • OR Complete Change of Correspondence Address Form SB/122 (single application) and fax to 571-273-8300, or mail to:
    • Commissioner for Patents
    • P.O. Box 1450
    • Alexandria, VA 22313-1450
  • OR Complete Customer Number Upload Spreadsheet SB/125 (multiple applications) and mail the CD or USB memory stick to:
    • Mail Stop EBC Customer Number
    • Commissioner for Patents
    • P.O. Box 1450
    • Alexandria, VA 22313-145011
Digital Certificate Request Process
(Post Initial Filing)

- No PKI
  - Files New Patent Application Online
  - 3-4 Wk

- User Requests PKI
  - Certificate Action Form + Customer Number Request (if user has no CN)
  - 5-7 Days

User Receives PKI

User Receives Notice from USPTO

Files Timely Response via EFS-Web

Invention-Con 2017 Filing for a Patent
Registered eFiler

• Has both an assigned Customer Number and Digital Certificate for secure access to application documents both during and after the filing of a patent application
  • Provides ability to authenticate sessions by requiring positive identification of a customer using Public Key Infrastructure technologies
• Can save "in-progress" submissions and return to edit them prior to completing filing
  • Provides added protection against loss of data in the event of a localized internet or office equipment failure or in the event of an unplanned system outage during an online filing session
• Can electronically process subsequent actions on electronically filed cases without delay
• Can review their confidential Private PAIR records for most of their electronically filed cases
Registered vs Unregistered EFS-Web

• EFS-Web Unregistered
  • (Without Digital Certificate)

Welcome to Electronic Patent Filing for UNREGISTERED eFILERS

A submission has not been filed officially at the USPTO until the e-filer enters the required information below.

All items denoted by * are required.

Maintenance Advisory: Firefox released Firefox 52 on March 7, 2017. This iteration has moved to a new server. For more information see the EFS-Web Announcements page.

IMPORTANT: Please read the Legal Framework for using EFS-Web. For information on statements under 37 CFR 1.501, please see the OMB Clearance and PRA Burden Statement page.

Sign-on as an UNREGISTERED eFILER

* e-Filer Last Name:

* e-Filer First Name:

* e-Filer E-Mail Address:

• EFS-Web Registered
  • (With Digital Certificate and Customer Number)
Unregistered vs Registered eFiling

**Unregistered eFiler**
- Basic initial filing of new patent applications, third party submissions, and auto-processed petitions (age & maintenance fee)
- Submission must be completed in one session

**Registered eFiler**
- Enhanced filing, follow-on processing, and other submission types available (such as ePetitions)
- Access to secured features, such as Saved Submission Packages and Acknowledgement Receipts
- Access to pending application in Private PAIR (Digital certificate and Customer Number)
Accepted Document Formats

**PDF Files**
General Documents

**Text Files**

**DOCX Files**
Initial Applications
(Specification, Claims, Abstract)
Limited to eMod Text Pilot Program until Summer 2017

**PCT-SAFE Zip Files**
Generated zip files produced by the PCT-SAFE software

**JPEG Files**
Hague Reproductions (Drawings)
Electronic Filing Process

Access EFS-Web As Unregistered Filer

Access EFS-Web As Registered Filer

Choose Filing Type

Enter Applicant Information (New Applications Only)

Attach & Index Patent Application Documents

Review Documents

Calculate Fees (may be deferred)

Confirm & Submit

Pay Fees (may be deferred)

Receive Acknowledgement Receipt

Access Filing in Private PAIR (Registered Filer only)
Where does it go next?

- EFS-Web
- Formalities Review
- Classification and Assignment
- Examination
PAIR: Patent Application Information Retrieval

- **Public PAIR**: Public applications, published applications and issued patents

- **Private PAIR**: Pending applications, published applications, and issued patents, PAIR Administration
  - A Digital Certificate is required to access unpublished applications
  - To access unpublished applications:
    - Correspondence Address of the application needs to be associated to the Customer Number
    - Customer Number needs to be linked to the Digital Certificate of the PAIR user
Applicants’ Duty to Disclose
37 C.F.R. 1.56 – Duty to Disclose Information

• When filing a patent application with the USPTO, you have a “duty of candor and good faith” in dealing with the Office.

• This includes the “duty to disclose” all information you believe to be relevant to the examination of the patent application.

See MPEP § 2001
Applicants’ Duty to Disclose
37 C.F.R. 1.56 – Duty to Disclose Information (cont.)

• Who has the duty to disclose?

• “Individuals associated with the filing or prosecution of a patent application”
  • The inventor(s)
  • Attorney(s)/agent(s) who help with the application
  • Every other person who is substantively involved with the application
Applicants’ Duty to Disclose
37 C.F.R. 1.56 – Duty to Disclose Information (cont.)

• What needs to be submitted?
• Information that is “material” to patentability
• Information is “material” if:
  • It could be used by an examiner to reject a claim of the application; **OR**
  • It refutes a statement you made to the Office.
Applicants’ Duty to Disclose
37 C.F.R. 1.56 – Duty to Disclose Information (cont.)

• What needs to be submitted?

• Examples
  • Patents and publications material to your invention
  • Any previous selling or publicizing of the invention to the public
  • Inventorship conflicts
How do I submit information?

- Information should be submitted via an information disclosure statement (“IDS”)
  - The IDS should be filed as early in prosecution as possible to avoid potential fees. See 37 CFR 1.97 for the full timing requirements.
  - No fee is required for an IDS filed before the examiner’s 1st Office action, and in situations where information was later discovered by an individual with a duty to disclose.
  - Use of form PTO/SB/08A and 08B, “Information Disclosure Statement,” is encouraged to meet the content requirements of 37 CFR 1.98.
  - The form is available at: https://www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012
Applicants’ Duty to Disclose
37 C.F.R. 1.56 – Duty to Disclose Information (cont.)

• For more information on IDS practice see MPEP § 609.
  • https://www.uspto.gov/web/offices/pac/mpec/mpec-0600.pdf
• Link to tutorial on Filing an IDS:
  • https://www.uspto.gov/sites/default/files/ebc/portal/efs/dct_ids_tutorial.pdf
Basic Fees as of April 20, 2017

- **Provisional Utility Application**

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<th>Large Entity</th>
<th>Small Entity</th>
<th>Micro Entity</th>
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<td>Filing Fee:</td>
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- **Non Provisional Utility Application**

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<th>Micro Entity</th>
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<td>Search Fee:</td>
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<td>Issue Fee:</td>
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<td>Non-electronic Filing Fee:</td>
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- **Design Application**

<table>
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<tr>
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<th>Micro Entity</th>
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</thead>
<tbody>
<tr>
<td>Basic Filing Fee:</td>
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<tr>
<td>Search Fee:</td>
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<tr>
<td>Issue Fee:</td>
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</tr>
</tbody>
</table>

Fees are subject to change. See the current fee schedule at: [https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule#Patent Fees](https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule#Patent Fees)
Small Entity Status

An entity that:

• Falls within one of three categories:
  • A nonprofit organization, such as a university,
  • A person, such as an individual inventor
  • A small business concern meeting the standards set forth by the Small Business Administration (SBA), including the requirement that the number of employees, including affiliates, does not exceed 500 persons. See 13 CFR 121.801 through 121.805.

• And has not assigned, licensed or otherwise conveyed an interest in the invention to a non-small entity
Micro Entity Status (Gross Income Basis)

• To qualify for micro entity status on the gross income basis, the applicant must comply with the:
  • Small entity requirement
  • Application filing limit
  • Gross income limit on applicants and inventors
  • Gross income limit on parties with an ownership interest

• Use form PTO/SB/15A to certify status:
  http://www.uspto.gov/sites/default/files/forms/sb0015a.pdf
Certification of Micro Entity Status (Gross Income Basis)

CERTIFICATION OF MICRO ENTITY STATUS (GROSS INCOME BASIS)

Applicant Number or Case Number (if applicable)  Patent Number (if applicable)
First named inventor:  Title of invention:

The applicant hereby certifies the following—

(1) SMALL ENTITY REQUIREMENT – The applicant qualifies as a small entity as defined in 37 CFR 1.27.

(2) APPLICATION FILING LIMIT – Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.

(3) GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS – Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the “Maximum Qualifying Gross Income” reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(4) GROSS INCOME LIMIT ON PARTIES WITH AN “OWNERSHIP INTEREST” – Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the “Maximum Qualifying Gross Income” reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

SIGNATURE by an authorized party set forth in 37 CFR 1.320(b)

Signature:  Name:  Date:  Telephone:  Registration No.

☐ There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.
Patent Electronic Business Center (EBC)

- Offers in-depth technical support to external users of the USPTO’s Patent e-Commerce systems
- Submitting your Patent Application via EFS-Web
- Viewing Application information in Public and Private PAIR
- Searching for Patents in AppFT and PatFT
- Digital Certificate and Customer Number Issues and Assistance
- Java and Web Browser Problems
- Technical Problems or Errors with your Patent Application
- PDX/DAS Registration Inquires and Issues
- Technical Problems with Biotech Tools such as PatentIn and Checker

Contact Info

Hours: Monday – Friday, 6:00 AM – 12:00 Midnight (ET), except federal holidays

Telephone Numbers:
- Toll-Free: 866-217-9197
- Local: 571-272-4100

Email: ebc@uspto.gov
Additional Resources

- Pro Se Assistance Program: https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program
- Office of Innovation Development (OID):
  - https://www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources
- OID Inventor Info Chat: https://www.uspto.gov/patents-application-process/inventor-info-chat
Thank You!

Presented By:
Zandra Smith
Lisa Tran